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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,558	04/19/2004	Leonard S. Schultz	6749.05	3428

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EXAMINER
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PATEL, SHEFALI D

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/827,558	Applicant(s) SCHULTZ, LEONARD S.	
	Examiner Shefali D. Patel	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 43-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/24/04</u> .                                                            | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

1. This application claims the benefit of and is a continuation of the application 09/860,728 filed on May 18, 2001 (now U.S. Patent 6,735,329 issued on May 11, 2004).

### *Information Disclosure Statement*

2. The information disclosure statement (IDS) submitted on November 24, 2004 was filed in the parent application as well. The references are considered with the knowledge that they were filed and considered in the parent case. The submission is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statement has been considered by the examiner.

### *Claim Rejections - 35 USC § 102*

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
3. Claims 43-50, 56-60, 64-72 and 75-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US 6,253,210) (hereafter, "Smith").

With regard to **claim 43** Smith discloses a device for providing a text related to an image (Figures 1-2), comprising: a microprocessor (Mapping engine in Figure 1 and 2 is a processor); and a library of images (402, Figure 4) and related texts (404, Figure 4), each of the images being associated with at least a portion of one of the related texts, wherein an image from outside the library (col. 4, lines 64-65, where MR images are part of collected patient data outside the library to be prepared for correlation processing against related databases) may be compared to the images in the library (col. 4, lines 44-48, where relating of points in the subject data is the comparing of the outside images to the images of the database or the library) and, based on the comparison, one of the images may be selected, thereby selecting at least a portion of the related text (col. 6, lines 8-14, where selecting all or portions the related texts through

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prior filtering or just by manually highlighting the text of interest and selecting none is inherently taught due to not selecting the unrelated text material for the specific procedure).

With regard to **claims 44 and 45** Smith discloses the library of images and associated text digital and the image from outside the library is digital at col. 8, lines 11-17, where digital storage of images and text is inherent to the invention as the capability of the apparatus is discussed in the passage.

With regard to **claim 46** Smith discloses at least a portion of one of the related texts adapted to be inserted in a record as seen in bottom right of Figure 6 and its respective portion in the specification.

**Claim 47** recites identical features as claim 43 except claim 47 is a device for surgical procedure claim. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 47. Applicant's attention is invited to the summary of Smith's invention, Figure 2 and its respective portion in the specification at col. 4-5, where the invention is disclosed for surgical procedure.

**Claim 48** recites identical features as claims 44-45. Thus, arguments similar to that presented above for claims 44-45 is equally applicable to claim 48.

With regard to **claim 49** Smith discloses the image from outside the library is a recorded image (col. 5, line 66 through col. 6, line 3, where pre-stored profiles or histories are the recorded data being presented to the search).

With regard to **claim 50** Smith discloses the image from outside the library is a real-time image (col. 7, lines 14-30, where imaging of the patient is in real-time is taught as discussed with regards to term "during" the medical procedure or surgery according to the passage)

**Claim 56** is rejected the same as claim 43. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 56. Claim 56 distinguishes from claim 43 only in that it recites a method for providing a medical record instead of a device. Also, claim 43 recites capturing a library video image of a medical procedure; processing said video image to provide a library digital image signal

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(Smith: col. 6, lines 58-60, where video images are provided in the database 402 and according to column 8, Lines 11-14, images are digitally processed); creating a text description of said video image (col. 6, lines 58-60, where text database descriptive of the video is also provided at 404); capturing an outside video image of an outside medical procedure and processing the outside video image to provide outside digital image signal (col. 4, lines 64-65, where MR images are the captured images during a procedure and they are inherently digitally processed); and comparing the library digital image signal and the outside digital image signal, wherein, if the library digital image and the outside digital image are similar the text description is selected to become at least a portion of the medical record (col. 6, lines 3-14, where mapping engine 206 performs the comparison of the patient data comprising of image data or a video image to the corresponding data in a database and generate the pre-created text corresponding to the correlated image in the database with a selecting interface to select all or part of the descriptive text).

With regard to **claim 57** Smith discloses a plurality of library video images and respective library digital image signals, and text descriptions are captured, processed, and created (Figure 4, elements 402, 408 and 404 represent video images, digital images and corresponding text data respectively).

With regard to **claim 58** Smith discloses the digital image signals and text descriptions comprising an electronically accessible database (Figure 4, Items 402 and 404 represent video and corresponding text data respectively which are electronically separately accessible databases)

With regard to **claim 59** Smith discloses a method of evaluation comprising the steps of: creating a collection of images (col. 4, lines 62-67); and comparing an image from outside the collection to the images in the collection (col. 5, lines 1-8, where the comparing of images is performed by item 206, and the images in the collections are the part of the co-registered data in the specific databases), wherein comparing leads to the selection of an image in the collection generally corresponding to the image from outside the collection (col. 6, lines 8-14, where selecting all or portions the related texts through prior

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filtering or just by manually highlighting the text of interest and selecting none is inherently taught due to not selecting the unrelated text material for the specific procedure).

With regard to **claim 60** Smith discloses the step of providing a library of texts (element 404, Figure 4), each image of the collection of images being associated with at least a portion of one of texts of the library of texts (col. 6, lines 8-14, where selecting all or portions the related texts through prior filtering or just by manually highlighting the text of interest).

With regard to **claim 64** Smith discloses a method of evaluating a medical condition comprising the steps of: creating a collection of images of medical conditions (col. 4 lines 62-67); and comparing another medical condition to the images in the collection (col. 5, lines 1-8, where the comparing of images is performed by item 206, and another medical condition is the part of the co-registered data in the specific databases); wherein at least a portion of the comparing is accomplished by a microprocessor (portion of the comparing is executed by mapping engine in Figure 1 and 2, a processor).

With regard to **claim 65** Smith discloses the collection of images being digital (col. 8, lines 11-17).

With regard to **claim 66** Smith discloses capturing images of the outside medical condition (col. 5, lines 35-44).

With regard to **claim 67** Smith discloses digitizing the images of the outside medical condition (col. 8, lines 11-17, where digitizing of images is inherent in the process).

With regard to **claim 68** Smith discloses the step of creating a collection of descriptions (col. 4 lines 62-67), each description generally corresponding to one or more of the images in the collection of images (col. 5 lines 41-51, mapping relationships).

With regard to **claim 69** Smith discloses the step of selecting from the collection of descriptions a description generally corresponding to the outside medical condition (col. 6, lines 8-14).

With regard to **claim 70** Smith discloses the steps of selecting one of the collection of images as being similar to the outside medical condition selecting the description from the collection of descriptions generally corresponding to the selected image (col. 6, lines 8-14, where selecting all or portions the related texts through prior filtering or just by manually highlighting the text of interest and selecting none is inherently taught due to not selecting the unrelated text material for the specific procedure).

With regard to **claim 71** Smith discloses the step of including the selected description in a medical record (col. 5, lines 35-44).

**Claim 72** recites identical features as claim 43. Thus, arguments similar to that presented above for claim 43 is equally applicable to claim 72.

**Claim 75** is rejected the same as claim 56. Thus, arguments similar to that presented above for claim 56 is equally applicable to claim 75. Claim 75 distinguishes from claim 56 only in that it recites selecting an image or group of image from the library images that is similar to the outside image and selecting the library text corresponding to the portion of the procedure corresponding with the selected library image. This is disclosed by Smith at col. 6, lines 8-14, where selecting all or portions the related texts through prior filtering or just by manually highlighting the text of interest and selecting none is inherently taught due to not selecting the unrelated text material for the specific procedure.

**Claims 76-77** is rejected the same as claims 44-45. Thus, arguments similar to that presented above for claims 44-45 is equally applicable to claims 76-77.

With regard to **claim 78** Smith discloses selecting an image and selecting the library text are accomplished by a microprocessor (portion of the comparing is executed by mapping engine in Figure 1 and 2, a processor and selected at col. 6 lines 8-14).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Stolfo (US 5,668,897).

With regard to **claim 51** Stolfo discloses an apparatus for producing a record comprising: means for manipulating data, including storing a plurality of images and a plurality of texts, at least a portion of each text being associated with one of the plurality of images (col. 8, lines 61-65, where images and text or codes are stored in the library); means for comparing an outside image to the plurality of images and for selecting one of the plurality of images that is similar to the outside image (col. 14, lines 51-59); and means for selecting the one of the texts associated with the selected image (col. 15, lines 45-51, where the code is the selected text of the associated template of the image).

With regard to **claim 52** Stolfo discloses the selected text being descriptive of the outside image (col. 8 lines 61-65 and col. 23 lines 9-16).

With regard to **claim 53** Stolfo discloses the apparatus further comprising means for digitizing said images (Column 7, Lines 7-16).

With regard to **claim 54** Stolfo discloses, the apparatus further comprising means for communicating said images and texts (Column 18, Lines 1-4).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 55, 61-63 and 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stolfo (US 5,668,897) in view of Smith et al. (US 6,253,210) (hereafter, "Smith").



With regard to **claims 55 and 63** discloses the apparatus as disclosed above in claim 43 and the arguments are not repeated herein, but are incorporated by reference. Stolfo does not expressly disclose images depicting aspects of medical procedures. Smith discloses images comprise aspects of medical procedures (Column 5, Lines 35-44). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Smith with Stolfo. The motivation for doing so is to further help monitor medical condition of a patient with respect to patient's present and past images. Therefore, it would have been obvious to combine Smith with Stolfo to obtain the invention as specified in claim 55.

With regard to **claims 61-62** Stolfo discloses the step of comparing the selected image from the collection to the image from the outside the collection and identifying similarities and differences between the two the selected image and the image from outside the collection (col. 14, line 66 through col. 15, line 2, where similarities are inherently checked in matching step and differences are to be checked after matching).

With regard to **claim 73** Stolfo discloses one or more remote accesses at col. 29, lines 4-8.

With regard to **claim 74** Stolfo discloses said remote accesses comprise an in-wall connector (col. 29, lines 4-8, where in-wall connectors are inherent since the citation refers to processors at different cites).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

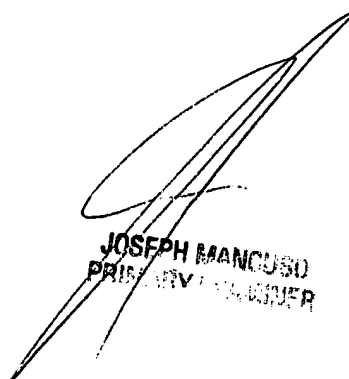
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on (571) 272-7695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel  
Examiner  
Art Unit 2621

October 28, 2005



JOSEPH MANCUSO  
PRIMARY EXAMINER